

Claims 26, 28-34 and 36-41 stand rejected under 35 U.S.C. §112, first paragraph.

Claims 26, 28-34 and 36-41 stand rejected under 35 U.S.C. §251.

Claims 26, 30, 31, 33, 34, 36, 37, 40, and 41 have been amended herein.

Reconsideration of the above-identified application, as herein amended, is respectfully requested.

The Examiner has rejected reissue application claims 26, 28-34 and 36-41 under 35 U.S.C. §251 as being an improper recapture of claimed subject matter which allegedly broadens the scope of the claims of the original patent upon which the present reissue is based. The Examiner asserts that the limitations added during the original patent prosecution must be included in the newly added reissue application claims. In support of the rejection, the Examiner cited In re Clement, 45 U.S.P.Q. 2d 1161 (Fed. Cir. 1997).

Applicant respectfully submits that In re Clement is not applicable to the claims here in issue and that a more recent decision by the Federal Circuit in Hester Industries, Inc v. Stein Inc., 46 U.S.P.Q.2d 1641 (Fed. Cir. 1998) is more relevant to the facts of the present application. In Hester, the court stated that the recapture rule does not apply if the reissue claims have been materially narrowed in other overlooked aspects of the invention. The purpose of this exception is to allow the patentee to obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspects according to the court. Id. at 1650.

Indeed, MPEP §1412.02 expressly instructs: "Where the reissue claims also include some narrowing limitation not present in the claims deliberately cancelled in the application, the Examiner must determine whether that narrowing limitation has a material aspect to it. If the narrowing limitation has a material aspect to it, then there is no recapture." But, as noted by the

MPEP, "if the narrowing limitation is incidental, mere verbiage, or would be inherent even if not recited (in view of the specification), then the claims should be rejected under USC §251 using form paragraph 14.17."

Unlike the reissue claims in Hester, which were ultimately barred by the recapture doctrine because only immaterial limitations were added, the reissue claims of the present application contain significant material limitations which were overlooked in the original patent prosecution, namely:

Asymmetrically drying the paper web in its thickness direction extending between the top and bottom sides of the paper web to a solids content at which curl-inducing stresses are formed in the paper web by passing the paper web through a plurality of top-felted single-tier normal dryer groups, each of the plurality of normal dryer groups including a single tier of dryer cylinders, a plurality of guide rolls disposed below and between the dryer cylinders, and a single wire transporting said web over the dryer cylinders and beneath the guide rolls so that only the bottom side of the web engages the dryer cylinders.

A person of ordinary skill in the art will readily recognize that the scope of the reissue claims is materially narrower than that of the original application claims. By way of illustration, the original application claims include within their scope both symmetric and asymmetric drying of a paper web by numerous types of dryer sections including, for example: a double felted double tier drying section, a serpentine drying section, a top felted double tier drying section, a bottom felted double tier drying section, and an alternating drying section having a top-felted dryer section followed by a bottom-felted dryer section. On the other hand, the reissue claims

require that the paper web be asymmetrically dried and by one only one type of drying section, i.e. one comprising a plurality of top-felted single-tier normal dryer groups. ✓

Applicant respectfully submits that the pending reissue claims thus avoid the effect of the recapture doctrine as they contain material limitations directed to overlooked aspects of the invention. Accordingly, the rejection under the recapture doctrine should be withdrawn.

The Examiner has also rejected reissue application claims 26, 28-34 and 36-41 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the original patent specification in such a way to reasonably convey to one skilled in the art that the inventor, at the time the application was filed, had possession of the claimed invention. The Examiner asserts that the original patent is limited to the introduction of moisture into a paper web through the means of applying steam. In support of the rejection, the Examiner has cited two recent Federal Circuit decisions, namely, The Gentry Gallery, Inc. v. The Berkline Corp., 45 U.S.P.Q.2d 1498, (Fed. Cir. 1998) and Tronzo v. Biomet Inc., 47 U.S.P.Q.2d 1829, (Fed. Cir. 1998).

✓ Applicant has carefully reviewed the holdings of these cited cases with respect to the written description requirement of 35 U.S.C. §112. However, Applicant respectfully submits that these cases do not apply to presently amended claims 26 and 34 which require that "heat and moisture" be applied to an asymmetrically dried paper.

In Gentry, the patent-at-issue discloses a sectional sofa having a console disposed between two reclining seats and a recliner control located on the console. The patentee argued that locating the control on the console is a critical element of the invention. The court concluded that locating the recliner control anywhere but on the console is outside the stated

purpose of the patent. Since the broadest claim does not require the recliner control to be located on the console, the court held the claim invalid under 35 U.S.C. §112, first paragraph.

Gentry, however, is factually distinguishable from the present case. The limitation "applying heat and moisture" recited in amended claims 26 and 34 is fully supported by the disclosure. Indeed, the present specification expressly discloses that:

In the invention, the relaxation of the paper may be based on an equalization of the properties of the web so that a controlled change is performed in the properties of the paper web (in a way similar to annealing), whereby the paper is regulated to higher uniformity. In the present invention, this controlled change is accomplished by means of moisture and temperature.

By means of the invention, the "flaws" that produce the tendency of curling of paper are corrected in the area of their formation or substantially immediately thereafter, in which case the correction can be made more advantageously and more efficiently.

See, col. 4, lines 10-21. (emphasis added.)

In Tronzo, the patent-at-issue relates to artificial hip sockets that include cup implants adapted for insertion into an acetabular, or hip, bone. The patent there at issue described two species of cups: an "eccentric cup" having a top lip shorter than a bottom lip, and a "true" cup having equal sides. Importantly, it also distinguished prior art shapes as inferior while touting the advantages of the conical shaped cup. The court concluded that the patent-at-issue disclosed only conical shaped cups, and held that the later-filed claims directed to generic cups covering prior art shapes are invalid under 35 U.S.C. §112, paragraph 1 for lack of adequate description.

Tronzo is also factually distinguishable from the present case. The present application does not engage in any comparative analysis of the various means of applying moisture and heat to the paper web, as does the patent-at-issue in Tronzo. Nor does it specifically distinguish steam boxes from other moisture and heat application devices. As was mentioned above, the present specification clearly discloses that curl control can be achieved by applying moisture and

heat to the paper web. A person of ordinary skill in the art will readily recognize from the disclosure that steam is but a preferred medium for such application.

It is well settled that the claims need not be limited to the preferred embodiment. See, Ethicon Endo-Surgery, Inc. v. United States Surgical Corp., 40 U.S.P.Q. 2d 1010 (Fed. Cir. 1993). It is respectfully submitted that the effect of the Examiner rejection under §112 results exactly in such a limitation. Thus, Applicant respectfully submits that the Examiner's restrictive reading of the specification is unwarranted and unnecessary and that amended claims 26 and 34 meet the written description requirement of 35 U.S.C. §112.

For the same reasons, dependent claims 28-33, and 36-41 also overcome the rejections.

In view of the discussion and arguments set forth above, it is submitted that all claims currently pending in the above-identified application are now in condition for allowance, the earliest possible notification of which is earnestly solicited. If in the Examiner's opinion prosecution of the present application would be advanced by a personal interview, the Examiner is invited to contact the undersigned at the telephone number listed below.

It is believed that no fees or charges are required at this time in connection with the present application; however, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,

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